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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,503	04/23/2001	Edwin J. Iwanowicz	QA231 NP	4455

23914 7590 08/20/2003

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EXAMINER

LIU, HONG

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/840,503

Applicant(s)

IWANOWICZ ET AL.

Examiner

Hong Liu

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1624

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See the Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 41.

Claim(s) rejected: 10-23,30-35 and 37-40.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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*Attachment to the Advisory Action*


Applicant response in paper No. 12 is hereby acknowledged. Claims 10-23, 30-35, and 37-41 are pending in this application.

The amendment filed August 8, 2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance because claims 10-23, 30-35, and 37-41 will be rejected under U.S.C. 35, 112, first paragraph for lack of written description. The proviso in claim 1 recites the limitation that "when R1 is alkyl, substituted alkyl, or alkenyl, R2 is not cyano." and "when R2 is cyano R1 is not alkyl, substituted alkyl or alkenyl." There is no such disclosure in the specification. Therefore, the negative limitation has no basis in the original disclosure. The MPEP at 2173.05(I) Negative Limitation states "Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.*, 738 F. 2d 453 (Fed. Cir. 1984)" and further, "Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement." In the instant case, the new concept that has been introduced by the proviso is the specific relationships between R1 and R2. This specific relationship of connectivity was previously not disclosed. This notion that the definition of one variable depends on the definitions of other variables is new. The definition of a variable is no longer independent.

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Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

Hong Liu  
August 18, 2003

  
**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**